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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,385	09/28/2001	Mark Kirkpatrick	BS01-170	2337

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,385

Applicant(s)

KIRKPATRICK, MARK

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/5/2005 has been entered.

Response to Amendment

2. This Office action is in response to the amendment filed 7/21/2005.

Information Disclosure Statement

3. The information disclosure statement 7/21/2005 has been considered.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-11 of copending Application No. 10/101,724. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations, such as a first battery, a first sound generating device, a second battery, a second sound generating device, an external connector socket, etc., are transparently found in the copending Application No. 10/101,724.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-10, 12-14, 16-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al. (US PAT. 5,767,778 hereinafter Stone) in view of Sawada et al. (US PAT. 6,810,274 hereinafter Sawada).

Regarding claim 1, Stone discloses a battery assembly system for a cellular telephone (11, figure 3) comprising a first battery (12, figure 3) for providing power to the cellular

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telephone and having terminals for establishing an electrical connection with the cellular telephone, a first sound generating device (13, figure 3) attached to the first battery and comprising a memory (42, figure 4) for storing a first sound file, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon receiving an electrical signal produced by the cellular telephone through the terminals; i.e., a specific power consumption pattern characteristic of an incoming call received, from the cellular phone (32, figure 4) at the current sensor (35, figure 4), upon detection of a telephone call by the cellular telephone (col. 2 lines 16-18 and col. 4 line 12 through col. 6 line 5). In addition, Stone also teaches the first sound file being downloaded from external available programming device (col. 7 lines 10-31). Stone differs from the claimed invention in not specifically teaching the first sound file being downloaded from a removable memory device attachable to the first battery and a second battery for providing power to the cellular telephone and having a terminals for establishing an electrical connection with the cellular telephone such that a second sound generating device attached to the second battery and comprising memory for storing a second sound file downloaded from the removable memory device attachable to the second battery where the second sound file is different from the first sound files wherein the second sound generating device is triggered to play sound associated with the second sound file when the second battery is installed in the cellular telephone upon receiving an electrical signal produced by the cellular telephone through the terminals upon detection of the telephone call by the cellular telephone. However, Sawada teaches a portable telephone apparatus having a portable telephone unit and a battery pack mounted thereto, wherein the battery pack includes an opening in which a semiconductor memory is removably

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inserted and a memory controller for controlling the operation of reading data stored in the semiconductor memory inserted in the opening in accordance with a control signal (col. 3 lines 28-53), wherein the portable telephone unit can be accessible to plural battery packs so that the portable telephone unit can freely choose and reproduce an audio signal without changing the semiconductor memory of the memory when user carries plural battery packs including plural sound files, thereby making user friendly (col. 5 line 62 through col. 6 line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in having the first sound file being downloaded from a removable memory device attachable to the first battery and a second battery for providing power to the cellular telephone and having a terminals for establishing an electrical connection with the cellular telephone such that a second sound generating device attached to the second battery and comprising memory for storing a second sound file downloaded from the removable memory device attachable to the second battery where the second sound file is different from the first sound files wherein the second sound generating device is triggered to play sound associated with the second sound file when the second battery is installed in the cellular telephone upon receiving an electrical signal produced by the cellular telephone through the terminals upon detection of the telephone call by the cellular telephone, as per teaching of Sawada, in order to make user friendly.

Regarding claim 2, Stone teaches the sound files can be being designated as audio alert signals for the telephone (col. 2 lines 16-18) and Sawada teaches a plural sound generating devices storing a plurality of sound files where at least some of the plurality of sound files from

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one generating device are different than the plurality of sound files of the other (col. 6 lines 2-7).

Thus, the claimed limitations are taught by the combination of Stone and Sawada.

Regarding claim 3, Stone teaches an external connector socket on the battery in electrical communication with the first sound generating device to provide external access to the plurality of sound files in the first sound generating device (col. 7 lines 21-23).

Regarding claim 5, Stone discloses a battery assembly system for a cellular telephone (11, figure 3) comprising a first battery (12, figure 3) for providing power to the cellular telephone and having terminals for establishing an electrical connection with the cellular telephone, a first sound generating device (13, figure 3) attached to the first battery and comprising a memory (42, figure 4) for storing a first sound file, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon receiving an electrical signal produced by the cellular telephone through the terminals, i.e., a specific power consumption pattern characteristic of an incoming call received from the cellular phone (32, figure 4) at the current sensor (35, figure 4), upon detection of a telephone call by the cellular telephone (col. 2 lines 16-18 and col. 4 line 12 through col. 6 line 5). In addition, Stone also teaches the first sound file being downloaded from external available programming device comprising an external connector socket (43, figure 4) on the first battery in electrical communication with the first plurality of sound files in the first sound generating device and a selector (41, figure 4) on the first battery for designating a sound files from the first plurality of sound files to use as an audio alert signal (col. 6 line 47 through col. 7 line 31). Stone differs from the claimed invention in not specifically teaching the first sound file being downloaded from a removable memory device attachable to

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the first battery and a second battery for providing power to the cellular telephone and having terminals for establishing an electrical connection with the cellular telephone such that a second sound generating device attached to the second battery and comprising memory for storing a second sound file downloaded from the removable memory device attachable to the second battery where the second sound file is different from the first sound files wherein the second sound generating device is triggered to play sound associated with the second sound file when the second battery is installed in the cellular telephone upon receiving an electrical signal produced by the cellular telephone through the terminals upon detection of the telephone call by the cellular telephone. However, Sawada teaches a portable telephone apparatus having a portable telephone unit and a battery pack mounted thereto, wherein the battery pack includes an opening in which a semiconductor memory is removably inserted and a memory controller for controlling the operation of reading data stored in the semiconductor memory inserted in the opening in accordance with a control signal (col. 3 lines 28-53), wherein the portable telephone unit can be accessible to plural battery packs so that the portable telephone unit can freely choose and reproduce an audio signal without changing the semiconductor memory of the memory when user carries plural battery packs including plural sound files, thereby making user friendly (col. 5 line 62 through col. 6 line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in having the first sound file being downloaded from a removable memory device attachable to the first battery and a second battery for providing power to the cellular telephone and having terminals for establishing an electrical connection with the cellular telephone such that a second sound generating device attached to the second battery and comprising memory for storing a second sound file downloaded from the

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removable memory device attachable to the second battery where the second sound file is different from the first sound files wherein the second sound generating device is triggered to play sound associated with the second sound file when the second battery is installed in the cellular telephone upon receiving an electrical signal produced by the cellular telephone through the terminals upon detection of the telephone call by the cellular telephone, as per teaching of Sawada, in order to make user friendly.

Regarding claim 6, the limitations of the claim are rejected as the same reasons as set forth in claim 5.

Regarding claim 7, the limitations of the claim are rejected as the same reasons as set forth in claim 1.

Regarding claim 8, Stone teaches the first sound generating device storing a plurality of sound files that are capable of being edit (col. 7 lines 10-31).

Regarding claims 9-10, the limitations of the claim are rejected as the same reasons as set forth in claim 3.

Regarding claim 12, the limitations of the claim are rejected as the same reasons as set forth in claim 1.

Regarding claims 13-14, the limitations of the claim are rejected as the same reasons as set forth in claim 3.

Regarding claim 16, the limitations of the claim are rejected as the same reasons as set forth in claim 1.

Regarding claims 17-19, the limitations of the claim are rejected as the same reasons as set forth in claim 5. In addition, Sawada discloses to insert the memory device (3, figure 2) into the memory device receive slot (5, figure 2) of the battery pack (col. 3 lines 16-27).

Regarding claim 21, Stone discloses a method of providing an audio alert signal for a cellular telephone (32, figure 4) comprising the steps of providing a first battery (30, figure 4) having terminals for receiving a signal from the cellular telephone, the first battery including a first programmable sound generating device having at least one file, and installing the first battery in the cellular telephone such that a sound file of the first sound generating device is activated upon receiving an electrical signal produced by the cellular telephone through the terminals of the first battery upon detection of a telephone call by the cellular telephone when desiring to hear the at least one file of the first sound generating device (col. 6 line 47 through col. 7 line 31). Stone differs from the claimed invention in not specifically teaching the step of providing a second battery for the cellular telephone and having terminals for receiving a signal from the cellular telephone, in which the second battery includes a second programmable sound generating device having at least one sound file different from the at least one sound file of the first programmable sound generating device, and installing the second battery in the cellular telephone such that the sound file of a sound file of the second sound generating device is activated upon receiving an electrical signal produced by the cellular telephone through the terminals of the second battery upon detecting of a telephone call by the cellular telephone when desiring to hear at least one sound file of the second sound generating device. However, Sawada teaches a portable telephone apparatus having a portable telephone unit and a battery pack mounted thereto, wherein the battery pack includes an opening in which a semiconductor

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memory is removably inserted and a memory controller for controlling the operation of reading data stored in the semiconductor memory inserted in the opening in accordance with a control signal (col. 3 lines 28-53), wherein the portable telephone unit can be accessible to plural battery packs so that the portable telephone unit can freely choose and reproduce an audio signal without changing the semiconductor memory of the memory when user carries plural battery packs including plural sound files, thereby making user friendly (col. 5 line 62 through col. 6 line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stone in having the step of providing a second battery for the cellular telephone and having terminals for receiving a signal from the cellular telephone, in which the second battery includes a second programmable sound generating device having at least one sound file different from the at least one sound file of the first programmable sound generating device, and installing the second battery in the cellular telephone such that the sound file of a sound file of the second sound generating device is activated upon receiving an electrical signal produced by the cellular telephone through the terminals of the second battery upon detecting of a telephone call by the cellular telephone when desiring to hear at least one sound file of the second sound generating device, as per teaching of Sawada, in order to make user friendly.

8. Claims 4, 11, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al. (US PAT. 5,767,778 hereinafter Stone) in view of Sawada et al. (US PAT. 6,810,274 hereinafter Sawada) as applied to claims above, and further in view of Haraguchi (US PAT. 6,597,279).

Regarding claim 4, Stone teaches a selector device on the shell for selecting plurality of sound files and designating a sound file to use as an alert signal (col. 5 lines 10-25 and col. 7 lines 16-20). The combination of Stone and Sawada differs from the claimed invention in not specifically teaching a user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Stone and Sawada in having the user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Regarding claim 11, the limitations of the claim are rejected as the same reasons as set forth in claim 4.

Regarding claim 15, the limitations of the claim are rejected as the same reasons as set forth in claim 4.

Regarding claim 20, Stone discloses a method of selecting a designated audio alert signal on a cellular telephone (11, figure 3) comprising the step of providing a first battery (12, figure 3) for the cellular telephone and having terminals for receiving a signal from the cellular telephone, the first battery including a first programmable sound generating device (31, figure 4) and a selector (41, figure 4) located on an outside surface, wherein the first sound generating

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device comprising a memory (42, figure 4) for storing a plurality of sound files, wherein the first sound generating device is triggered to play sound associated with the first sound file when the first battery is installed in the cellular telephone upon detection of a telephone call by the cellular telephone (col. 2 lines 16-18 and col. 4 line 12 through col. 6 line 5). In addition, Stone also teaches the first sound file being downloaded from external available programming device (col. 7 lines 10-31). Stone differs from the claimed invention in not specifically teaching the first sound file being downloaded from a removable memory device connectable to the first battery and providing a second battery including memory for storing a second sound file downloaded from the removable memory device connectable to the second battery, wherein selecting a selected sound from the first and second plurality of sound files by installing the first battery into the cellular telephone when desiring to hear the selected sound from the first plurality of sound files during cellular telephone operation and installing the second battery into the cellular telephone when desiring to hear the selected sound from the second plurality of sound files during cellular telephone operation. However, Sawada teaches a portable telephone apparatus having a portable telephone unit and a battery pack mounted thereto, wherein the battery pack includes an opening in which a semiconductor memory is removably inserted and a memory controller for controlling the operation of reading data stored in the semiconductor memory inserted in the opening in accordance with a control signal (col. 3 lines 28-53), wherein the portable telephone unit can be accessible to plural battery packs so that the portable telephone unit can freely choose and reproduce an audio signal without changing the semiconductor memory of the memory when user carries plural battery packs including plural sound files, thereby making user friendly (col. 5 line 62 through col. 6 line 7). Therefore, it would have been obvious to a person of ordinary skill

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in the art at the time the invention was made to modify Stone in having the first sound file being downloaded from a removable memory device connectable to the first battery and providing a second battery including memory for storing a second sound file downloaded from the removable memory device connectable to the second battery, wherein selecting a selected sound from the first and second plurality of sound files by installing the first battery into the cellular telephone when desiring to hear the selected sound from the first plurality of sound files during cellular telephone operation and installing the second battery into the cellular telephone when desiring to hear the selected sound from the second plurality of sound files during cellular telephone operation, as per teaching of Sawada, in order to make user friendly. Furthermore, neither Stone nor Sawada specifically teaching a user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Stone and Sawada in having the user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Response to Arguments

9. Applicant's arguments filed 7/21/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to disclose two batteries for a cellular telephone with each battery having a terminal for receiving a signal from the cellular telephone so that switching batteries allows the sounds to be changed and still be triggered by a signal from the cellular phone that is received through the terminal when a call is detected, it is noted that Stone clearly teaches a battery for a cellular telephone having a terminal for receiving a signal from the cellular telephone so that a sound file can be triggered by a signal from the cellular phone that is received through the terminals when a call is detected (col. 2 lines 16-18 and col. 4 line 12 through col. 6 line 5). Although Stone does not specifically teach two batteries for cellular telephone and switching the batteries allow the sound to be changed, Sawada teaches a portable telephone can be accessible to plural battery packs so that the portable telephone can freely choose and reproduce an audio signal without changing the semiconductor memory of the battery pack by the key operation of the portable telephone when the user carries plural battery packs (col. 6 lines 1-7). Thus, one skilled in the art would recognize to modify Stone in having two batteries for cellular telephone and switching the batteries allow the sound to be changed, as per teaching of Sawada, in order to make user friendly. Accordingly, the cited references teach that the signal provided from the cellular telephone to the battery to cause the sound to be triggered being provided through the same terminals of the battery that provide power to the cellular phone. As a result, the claimed limitations are rejected over the cited references.

Conclusion

10. This is a requested continuation examination of applicant's earlier Application No. 09/964,385. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

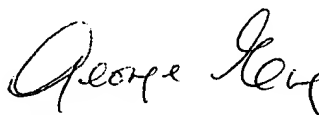
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 571-272-7495. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "George Eng".

George Eng
Primary Examiner
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